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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/748,759
Filing Date: December 30, 2003
Appellant(s): SCHOLL ET AL.

David C. Annis
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed January 19, 2011 appealing from the Office action mailed August 10, 2010.

(1) Real Party in Interest

The examiner has no comment on the statement, or lack of statement, identifying by name the real party in interest in the brief.

(2) Related Appeals and Interferences

The following are the related appeals, interferences, and judicial proceedings known to the examiner which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal:

Application number 11/043499 and 11/043503 are at the Board of Patent Appeals and Interferences.

(3) Status of Claims

The following is a list of claims that are rejected and pending in the application:

Claims 1, 2, 6-14, 16-21, 35 and 36 are rejected and pending.

(4) Status of Amendments After Final

The examiner has no comment on the appellant's statement of the status of amendments after final rejection contained in the brief.

(5) Summary of Claimed Subject Matter

The examiner has no comment on the summary of claimed subject matter contained in the brief.

(6) Grounds of Rejection to be Reviewed on Appeal

The examiner has no comment on the appellant's statement of the grounds of rejection to be reviewed on appeal. Every ground of rejection set forth in the Office action from which the appeal is taken (as modified by any advisory actions) is being maintained by the examiner except

for the grounds of rejection (if any) listed under the subheading "WITHDRAWN REJECTIONS." New grounds of rejection (if any) are provided under the subheading "NEW GROUNDS OF REJECTION."

(7) Claims Appendix

The examiner has no comment on the copy of the appealed claims contained in the Appendix to the appellant's brief.

(8) Evidence Relied Upon

2005/0137939	CALABRIA et al.	6-2005
6,606,644	FORD et al.	8-2003

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:3

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 2, 4, 6-14, 16-21, 35 and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Calabria et al. (US 2005/0137939) in view of Ford et al. (US 6,606,644 B1).

Regarding claims 1 and 2 Calabria teaches one or more computer systems that collectively implement at least: a plurality of advertisement generators (keyword selection agent 52) that each use at least one algorithm to identify search terms corresponding to an item (selection of keyword or keyword combinations), determine at least one item-specific visual element (title or name of the book) (algorithm for selection of advertisement), create a link to information about the item, and generate an advertisement set (advertisement to be matched with the keyword or keyword combinations) [0052]-[0055] [0121]), for the item that includes at least one associated advertisement having the item-specific visual element, the link, and at least one search term matching the at least one keyword (see [0069]-[0072]); a fee calculator that at least calculates fee amounts for each of the advertisement sets generated by the advertisement generators based at least in part on anticipated profitability of the advertisement sets (see [0013], [0019] – [0023]; an advertisement manager that, at least: receives from the advertisement generators advertisement sets, receives from the fee calculator a fee amount for each of the generated advertisement sets, a fee calculator that at least calculates fee amounts for each of the advertisement sets generated by the advertisement generators based at least in part on anticipated profitability of the advertisement sets; an advertisement manager that, at least: receives from the advertisement generators advertisement sets, receives from the fee calculator a fee amount for each of the generated advertisement sets (see abstract, [0035]-[0040], [0044]- [0047], [0055]-[0059], [0109]). Calabria does teaches advertisement manager selects one of the generated advertisement sets for submission to the advertisement placement service and an advertisement

submitter receives from the advertisement manger the selected advertisement set and fee amount for the selected advertisement set and sends to the advertisement placement service a request to place the selected advertisement set along with content associated with the keyword at the fee amount of the selected advertisement set (see [0104]-[0109], [0119]-[0122]). Calabria does not explicitly teach determines whether at least one of the generated advertisement sets would avoid conflict with the submitted advertisement set with respect to the at least one search term of the submitted advertisement set and, when at least one of the generated advertisement sets is determined to avoid conflict, selects one of the generated advertisement sets determined to avoid conflict, it is taught in Ford. Ford teaches in the event that a given keyword maps to multiple advertisements database manager may pick randomly among the candidate advertisement or alternatively the user may impose special condition such as requiring a round robin scheduling, so as to avoid repetitions of specific advertisement (conflict) (see col. 11 line 58 to col. 12 line 15). Thus it would have been obvious to one of ordinary skill in the art at the time of the invention to select the advertisement of Calabria in a round robin scheduling as in Ford in order to avoid repetition of the specific advertisements, as taught in Ford.

Regarding claims 4, 7, 8, Calabria teaches the advertisement manager selects one of the generated advertisement sets based at least in part on determined likelihood of users selecting the advertisement when it is placed along with a content associated with the keyword; a database containing statistics relating to placements of advertisements and wherein the fee calculator determines anticipated profitability based on analysis of the statistics; wherein the statistics

include average cost-per-click of an advertisement and average revenue-per-click (see [0120]-[0123],[0133]- [0147]).

Regarding claim 6, Calabria teaches multiple advertisement submitters where each advertisement submitter is associated with a respective different advertisement placement service (see [0153]).

Regarding claims 9, 19, Calabria teaches under the control of one or more computer systems configured with executable instructions using each of a plurality of algorithms to at least: identify search terms corresponding to an item (selection of keyword or keyword combinations), determine at least one item-specific visual element (title or name of the book) (algorithm for selection of advertisement), create a link to information about the item, and generate an advertisement set (advertisement to be matched with the keyword or keyword combinations) [0052]-[0055] [0121]) for the item that includes at least one associated advertisement having the item-specific visual element, the link, and at least one search term matching the at least one keyword (see [0069]-[0072]); submitting one or more of the generated advertisement sets to an advertisement placement service with a bid amount (see [0104]-[0109], [0119]-[0122]). Calabria does not teaches determines whether at least one of the generated advertisement sets would avoid conflict with the submitted advertisement set with respect to the at least one search term of the submitted advertisement set and, when at least one of the generated advertisement sets is determined to avoid conflict, selects one of the generated advertisement sets determined to avoid conflict, it is taught in Ford. Ford teaches in the event that a given keyword maps to multiple advertisements database manager may pick randomly among the candidate advertisement or alternatively the user may impose special condition such

as requiring a round robin scheduling, so as to avoid repetitions of specific advertisement (conflict) (see col. 11 line 58 to col. 12 line 15). Thus it would have been obvious to one of ordinary skill in the art at the time of the invention to select the advertisement of Calabria in a round robin scheduling, as in Ford, in order to avoid repetition of the specific advertisements.

Regarding claims 10-14 and 16-18, Calabria teaches analyzing based at least in part on profit resulting from user selection of submitted one or more advertisement sets, the effectiveness of one or more submitted advertisement sets and wherein said selecting is based on least in part on said analyzing; calculating the bid amount based at least in part on advertising metrics collected by the advertiser; placing the advertisements associated with the submitted one or more advertisement sets with content associated with a keyword that matches the one or more identified search terms of the submitted one or more advertisement sets (see [0035]-[0040], [0044]- [0047], [0052]-[0060], [0109], [0121]).

Regarding claims 20 and 21, Calabria teaches filtering generated advertisement sets based on frequency of keywords in content or desirability of keywords (see [0054]-[0059]).

Regarding claims 35 and 36, Calabria teaches a computer program product embedded in a computer-readable medium comprising a program code for using a plurality of different algorithms (keyword selection agent 52) to identify search terms corresponding to an item (selection of keyword or keyword combinations), determine at least one item-specific visual element (title or name of the book), create a link to information about the item; program code to generate an advertisement set (advertisement to be matched with the keyword or keyword

combinations) [0052]-[0055] [0121]), for the item that includes at least one associated advertisement having the item-specific visual element, the link, and at least one search term of the identified search term (see [0069]-[0072]); program code for associating each generated advertisement set with a corresponding bid amount (see abstract, [0035]-[0040], [0044]- [0047], [0055]-[0059], [0109]). Calabria teaches program code for selecting one of the generated advertisement sets and submitting the selected one or more unsubmitted generated advertisement (generated advertisement) (see [0104]-[0109], [0119]-[0122]). Calabria does not explicitly teach determining whether at least one of the generated advertisement sets would avoid conflict with the submitted advertisement set with respect to the at least one search term of the submitted advertisement set and, when at least one of the generated advertisement sets is determined to avoid conflict and selecting one of the generated advertisement sets in a round-robin manner, it is taught in Ford. Ford teaches in the event that a given keyword maps to multiple advertisements database manager may pick randomly among the candidate advertisement or alternatively the user may impose special condition such as requiring a round robin scheduling, so as to avoid repetitions of specific advertisement (conflict) (see col. 11 line 58 to col. 12 line 15). Thus it would have been obvious to one of ordinary skill in the art at the time of the invention to select the advertisement of Calabria in a round robin scheduling, as in Ford, in order to avoid repetition of the specific advertisements, as taught in Ford.

(10) Response to Argument

Regarding claim 1, Appellant argues that Calabria does not disclose, teach or suggest the plurality of advertisement generators. Appellant further argues that Calabria does not teach or

suggest where each of the generators "identify search terms corresponding to an item," "determine at least one item-specific visual element," "create a link to information about the item", and "generate an advertisement set for the item that includes at least one associated advertisement having the item-specific visual element, the link, and at least one search term matching the at least one keyword."

However Calabria teaches the keyword advertisement management system may also include **one or more of** keyword selection agent 52, and advertisement selection agent 54 and an ROAI agent 56 (see [0041]). Further Calabria teaches the keyword selection agent 52 includes an algorithm for selection of keywords and keyword combination that are included in the keyword database 48 ... the advertisement selection agent 54 includes an algorithm for selection of an advertisement from the advertisement database 46 that is to be matched with a given keyword or keyword combination ... the ROA agent 56 may receive, for example, click through information associated with a given keyword/keyword combination and matched keyword advertisements (which indicates that the advertisement includes a link (URL)) (see [0052], see also [0069]-[0072]).

Appellant asserts that the keyword selection agent 52 of Calabria simply selects keywords and keyword combinations from a database, and in no way discloses, teaches, or suggests "a plurality of advertisement generators" that each "identify search terms corresponding to an item," "determine at least one item-specific visual element," "create a link to information about the item," and "generate an advertisement set for the item that includes at least one associated advertisement having the item-specific visual element, the link, and at least one search term matching the at least one keyword," as recited in claim 1.

Appellant further argues that paragraphs 52-55 of Calabria do not disclose, teach, or suggest "a plurality of advertisement generators" that each, among other things, "generate an advertisement set for the item that includes at least one associated advertisement having the item-specific visual element, the link, and at least one search term matching the at least one keyword," as recited in claim 1.

Examiner points out that the claim recites "advertisement generators" however the generators are used for creating "advertisement set" in which the set includes "advertisement, search term and a link". As claimed and in light of applicant's disclosure the function of the generators is not for generating advertisement but for generating "advertisement set". Calabria also uses generators for generating an "advertisement set" i.e., a set that includes an advertisement and keyword/keyword combination (wherein the keyword matches the at least one search term) and a link.

Regarding Ford Appellant states " It is implied in the Office Action that "pick[ing] randomly among the candidate advertisement[s] or... impos[ing] special condition such as requiring a round robin scheduling, so as to avoid repetitions of specific advertisements" as taught by Ford disclose, teaches, or suggests "determines whether at least one of the generated advertisement sets would avoid conflict with the submitted advertisement set with respect to the at least one search term of the submitted advertisement set and, when at least one of the generated advertisement sets is determined to avoid conflict, selects one of the generated advertisement sets determined to avoid conflict," as recited in claim 1. Applicants disagree". Appellant further asserts that Ford at col. 12, lines 9-15 discloses that "in the event that a given keyword maps to multiple advertisements," the "database manager 34 may pick randomly among

the candidate advertisements" or "the user may choose to specify a ranking amongst the acceptable candidates, or impose special conditions, such as requiring a round robin scheduling, so as to avoid repetition of specific advertisements." Appellant states that Ford discloses avoiding repetitions, whereas claim 1 recites avoiding conflicts.

The claim does not indicate what would be considered a "conflict". In order to understand what would be considered a conflict, Examiner referred to Appellant's disclosure. Appellant's disclosure teaches as follows (see [0038]).

In one embodiment, the advertisement sets may be generated automatically by a computer algorithm, manually by advertisers, or by some combination thereof. In one embodiment, **when multiple advertisement sets conflict**, the advertisement manager may submit the advertisement sets in a **round-robin manner** so the effectiveness of each advertisement set can be assessed and the most effective advertisement set can ultimately be submitted. Also, the bid amount may be modified based on the advertisement generator. For example, a certain advertisement generator may generate advertisement sets that have been historically much more effective than the advertisement set of other advertisement generators.

Regarding claims 9 and 35, Appellant states that the rejection of claims 9 and 35 cite the same paragraphs of the same references as the rejection of claim 1, therefore, at least for reasons including some of those discussed above in connection with claim 1, Applicant respectfully submit that claims 9 and 35 are allowable. Examiner has already addressed Appellant's argument regarding claim 1, which also addresses claims 9 and 35.

As indicated above since Calabria in view of Ford teaches the claim limitation of the independent claim, the rejection of the dependent claims is not improper.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

YR
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Primary Examiner, Art Unit 3622

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